



AF
JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 3722 Customer No.: 035811
Examiner : Jamila O. Williams
Serial No. : 09/711,194
Filed : November 13, 2000 Docket No.: 1391-CIP-00
Inventors : Casey William Norman
: Torquil Patrick Alexander Norman Confirmation No.: 6427
Title : DOLL'S CLOTHING AND PLAY SET
Dated: September 25, 2006

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Certificate of Mailing Under 37 CFR 1.8

For

Postcard

Appeal Brief with Claims Appendix, Evidence Appendix and Related Proceedings Appendix

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to **Mail Stop Appeal Brief - Patents**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date appearing below.

Name of Applicant, Assignee, Applicant's Attorney
or Registered Representative:

DLA Piper US LLP
Customer No. 035811

By: *Parag Patel*

Date: *June 29, 2007*



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 3722	Customer No.: 035811
Examiner	: Jamila O. Williams	
Serial No.	: 09/711,194	
Filed	: November 13, 2000	Docket No.: 1391-CIP-00
Inventors	: Casey William Norman	
	: Torquil Patrick Alexander Norman	Confirmation No.: 6427
Title	: DOLL'S CLOTHING AND PLAY SET	
		Dated: June 25, 2007

APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appellants have appealed from the final rejection of Claims 1, 3 – 16, 18, 20 and 21 on April 7, 2005. The Appellants submit this Appeal Brief in response to the Official Action dated May 17, 2007, which reopened prosecution for the second time after submission of the Appellants' Brief submitted September 25, 2006. A check in the amount of \$500.00 under 41 CFR §41.20(b)(2) was submitted with the Appellants' January 4, 2006 Brief. The Appellants respectfully submit that the earlier fee is applicable to this Brief.

REAL PARTY IN INTEREST

The real party in interest, by Assignment recorded in the USPTO records at Reel 011519 and Frame 0114 is Genie Toys, PLC, a corporation of the United Kingdom located at 25 Imperial Square, Cheltenham, Gloucestershire GL50 1QZ, United Kingdom.

RELATED APPEALS AND INTERFERENCES

Appellants filed a Notice of Appeal on July 12, 2005 for U.S. Patent Application Serial No. 09/844,322 filed on April 26, 2001. An Official Action dated March 28, 2006 reopened prosecution in that application. The Appeal is being reinstituted in that application.

STATUS OF CLAIMS

Claims 1, 3 – 16, 18, 20 and 21 are rejected and on appeal. Claims 2, 17 and 19 were canceled without prejudice and without disclaimer of the subject matter thereof. Claims 1, 6, 10, 13, 15, 20, and 21 are independent claims.

STATUS OF AMENDMENTS

The following Amendments and Response are of record: an Amendment filed on June 10, 2002 in response to the Non-final Official Action dated March 8, 2002; an Amendment filed March 21, 2003 in response to the Non-final Official Action dated September 25, 2002; an Amendment filed October 31, 2003 in response to the Non-final Official Action June 18, 2003; an Amendment filed June 14, 2004 in response to the Final Official Action dated March 5, 2004; a Request for Continued Examination filed August 3, 2004 in response to an Advisory Action dated July 16, 2004; an Amendment filed January 5, 2005 in response to the Non-final Official Action dated October 19, 2004; and a Notice of Appeal filed July 1, 2005 in response to the Final Official Action dated April 7, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1

The claimed subject matter relates to a seamless doll's skin comprising a seamless, injection molded elastomeric material sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which repeatedly covers and is removed from the doll and transforms the doll into a different character or object, has a wall thickness from 1 to 3mm, has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll. (See the Specification at page 4, lines 13 – 22; page 6, lines 10 – 11; page 6, line 19 to page 7, line 5; page 7, lines 6 – 13 and page 7, line 19 to page 8, line 20; and the Figures).

Claim 6

The claimed subject matter also relates to a seamless doll's skin comprising a seamless, injection molded elastomeric material which covers and is removed from at least a portion of a doll that is at least partially bendable or articulated and transforms the doll into a different character or object, wherein the elastomeric material has a 100% modulus of elasticity between about 120 and 350KN/m², has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll. (See the Specification at page 4, lines 13 – 22; page 6, lines 10 – 11; page 6, line 19 to page 7, line 5; page 7, lines 6 – 13 and page 7, line 19 to page 8, line 20; and the Figures).

Claim 10

The claimed subject matter further relates to a seamless doll's garment comprising a seamless, injection molded elastomeric material having a molded shape to repeatedly fit over and removed from a doll having a height in the range of above 8cm to about 20cm, has a through

hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at articulation locations of the doll. (See the Specification at page 4, lines 13 – 22; page 6, lines 10 – 11; page 7, line 19 to page 8, line 20; page 10, lines 4 – 14 and the Figures).

Claim 13

The claimed subject matter still further relates to a doll's skin comprising a seamless, injection molded elastomeric material which covers and is removed from at least a portion of a doll that is at least partially bendable or articulated and transforms the doll into a different character or object, and wherein the elastomeric material has a 100% modulus of elasticity between about 120 and 350KN/m², has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll. (See the Specification at page 4, lines 13 – 22; page 6, lines 10 – 11; page 6, line 19 to page 7, line 5; page 7, lines 6-13 and page 7, line 19 to page 8, line 20; and the Figures).

Claim 15

The claimed subject matter also relates to a play set comprising, in cooperative combination, a doll that is at least partially bendable or articulated having a height in the range of 8 cm to about 20 cm, donned and fitted with a seamless synthetic polymer injection molded garment which removeably encloses around at least a portion of the doll and is adapted to be removed, dressed and refitted again to the doll wherein the synthetic polymer has a 100% modulus of elasticity between about 120 and 350KN/m², has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll. (See the Specification at page 4, lines 13 – 22; page 6, lines 10 – 11; page 6, line 19 to page 7, line 5; page 7, line 19 to page 8, line 20; page 10, lines 4 – 14 and the Figures).

Claim 20

The claimed subject matter further relates to a seamless doll's garment comprising a seamless, injection molded elastomeric material sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which is repeatedly fitted over and removed from the doll, has a wall thickness from 1 to 3mm, has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll. (See the Specification at page 4, lines 13 – 22; page 6, lines 10 – 11; page 7, lines 6 – 13; page 7, line 19 to page 8, line 20; and the Figures).

Claim 21

The claimed subject matter yet further relates to a seamless doll's garment comprising a seamless, injection molded elastomeric material sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which is repeatedly fitted over and removed from the doll, wherein the elastomeric material has a 100% modulus of elasticity between 120 and 350KN/m², has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll. (See the Specification at page 4, lines 13 – 22; page 6, lines 10 – 11; page 6, line 19 to page 7, line 5; page 7, line 19 to page 8, line 20; and the Figures).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 4 – 7, 13 – 16, 18, 20 and 21 are provisionally rejected for obviousness-type double patenting over claims 20, 21, 28, 29, 31, 33 – 36, 38, 39, 41, 42 and 44 of Application No. 09/844,322.

Claims 1, 6 – 8, 10, 13 – 16, 20 and 21 are rejected under 35 U.S.C. §103(a) over O'Brian et al. (U.S. Patent No. 2,944,368) in view of Kramer (U.S. Patent No. 5,607,339) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036) and further in view of Washburn (U.S. Patent No. 4,063,402).

Claims 3-5 and 11 are rejected under 35 U.S.C. §103(a) over O'Brian (U.S. Patent No. 2,944,368) in view of Kramer (U.S. Patent No. 5,607,339) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036) and further in view of Yasuda (U.S. Patent No. 5,928,803).

Claim 12 is rejected under 35 U.S.C. §103 over O'Brian (U.S. Patent No. 2,944,368) in view of Kramer (U.S. Patent No. 5,607,339) and either Gross (U.S. Patent No. 5,913,708) or Wion (U.S. Patent No. 4,294,036) as applied to Claim 10 above and further in view of Fogarty (U.S. Patent No. 4,414,774).

Claims 1 and 9 are rejected under 35 U.S.C. §103(a) over Yasuda (U.S. Patent No. 5,928,803) in view of Kramer (U.S. Patent No. 5,607,339) and further in view of O'Brian (U.S. Patent No. 2,944,368).

ARGUMENT

Rejection of Claims 1, 6 – 8, 10, 13 – 16, 20 and 21 under 35 U.S.C. §103(a)

Claims 1, 6 – 8, 10, 13 – 16, 20 and 21 are rejected under 35 U.S.C. §103(a) over O'Brian in view of Kramer and either Gross or Wion and further in view of Washburn.

The Appellants respectfully submit that this is an untimely rejection raised only after many issued Official Actions utilizing the main prior art. This new rejection has now switched the order of the primary reference with one of the three secondary references. The Appellants

respectfully submit that switching the order does nothing to cure the deficiencies of that cited prior art because such a switch does not provide new disclosure by that prior art upon which to base a new rejection. The new rejection should have been made years ago. Also, adding a new tertiary reference is untimely. That too should have been done years ago.

In any event, the rejection begins by stating that O'Brian discloses in Figs. 1 – 7 a garment comprising a flexible and elastic molded thermoplastic elastomer. The rejection cites column 3, lines 54 – 56 and column 4, line 58 for support. The rejection relies on a quotation of a dictionary definition of the word “resilient.” The rejection admits that O'Brian does not disclose a doll having articulated limbs, dolls garments formed from a flexible sheet of polymeric plastic material between 2 MN and 6 MN in thickness and a modulus of elasticity of less 1 MN/M².

The Appellants decline to engage in a contest of dictionary comparisons, especially in view of the recent *Phillips*' Decision. Instead, the Appellants will rely on the ordinary meaning of the words in the rejected claims, the Appellants' Specification and in the O'Brian disclosure. In that regard, O'Brian discloses clothing as shown in Figs. 2 and 3 that is shaped to “snap” its hard plastic pieces onto a non-articulable doll such as a doll shown in Fig. 1. Such “snapping” action is a completely different mechanism to achieve positioning of clothing relative to the doll or a doll-like shape as compared to Kramer or as compared to the rejected claims.

The rejection relies on the notion of a single piece of resilient material that has a front and pair of sides and the front and sides are shaped so that at least a part of the article of apparel is curved to the rear of the article of apparel in a shape corresponding to the shape of a part of the doll and is adapted to resiliently engage the doll to hold the article of apparel in a predetermined position upon the doll. This is done when the article of apparel is “temporarily deformed” and

“snapped” into the predetermined position on the doll. This is set forth in column 4, beginning at line 58 as noted in the rejection and extending through to line 66.

However, the O’Brian approach is completely different from that of the rejected claims and Kramer. Also, the “resilient” material is completely different. The importance of the resilience is that the curved rear portions of the article of apparel can be “pried” apart sufficiently far enough to create a gap that is wide enough to fit around the doll and then upon release of the force used to enlarge the gap, “snap” back into the predetermined position. The Appellants respectfully submit that this is no way suggestive of an elastic material. Those skilled in the art know that elasticity refers to stretchability. This is in no way to be confused with the concept of a resilient material.

In any event, “snapping” an article on to a doll is not donning that article “in a life-like way” as claimed by the Appellants. “Snapping” is also not suggestive of “a life-like way.” O’Brian therefore leads those skilled in the art away from the subject matter of the rejected claims.

Additionally, O’Brian fails to disclose, teach or suggest injection molded thermoplastic elastomer. The Official Action of March 28, 2006 points to column 3, lines 54 – 56 of O’Brian, which is reproduced below in its entirety.

Preferably in manufacturing the doll 10 and the various articles of apparel illustrated, as well as the base utilized with this doll 10, a flat sheet 34 of any number of a number of thermoplastic materials, such as, for example, polyethylene, polystyrene or the like, is printed or otherwise similarly colored substantially as indicated in Fig. 6 of the drawings in various colors and shapes, etc. so that different portions of the sheet 34 correspond to the doll 10 and the various articles of apparel it is desired to utilize with this doll.

This portion of O’Brian is not applicable because it does not anywhere mention the word “elastomer.” As a result, O’Brian does not support the disclosure of an elastomer. In fact, the

Appellants have carefully scrutinized the entire text of O'Brian and the word "elastomer" never appears at any location. The clothing of O'Brian is rigid yet resilient (or semi-rigid under a liberal interpretation) and snapped on, which is critical because the snap-on clothing of O'Brian is just the type of clothing that the Appellants seek to avoid. The fact that O'Brian discloses a thermoplastic material in no way means that it discloses, teaches or suggests an elastomer. Those skilled in the art know that thermoplastic materials are soft when warm and hard when cool. However, that in no way makes them elastic. Elasticity is a completely different concept and physical phenomenon than plasticity. The term "plastic" merely refers to the ability to be molded whereas the term "elastic" refers to being easily stretched and then resuming the former shape. Thus, O'Brian fails to either explicitly or implicitly disclose, teach or suggest "injection", "elastomer" or "injection molded elastomer" which terms are explicitly recited in the Claims 1, 6 – 8, 10, 13 – 16, 20 and 21. Therefore, O'Brian fails to disclose, teach or suggest an injection molded thermoplastic elastomer. As a consequence, O'Brian is non-enabled as effective prior art against these rejected claims.

In sharp contrast to O'Brian and the rejected claims, Kramer discloses a sheet system, wherein sheets of material having selected characteristics may be formed into essentially a planar doll shape, *i.e.*, essentially two-dimensional, among other planar shapes. The characteristics of the sheet are selected so that, when wetted, the sheet sticks to a hard surface such as a ceramic surface. This results from surface tension between the sheet and the hard surface as created by an intervening layer of water, as is shown in Fig. 3 of Kramer.

Additionally, another layer of similar planar sheet material, cut into the form of clothes, is first wetted and then laid over the doll shaped sheet. Thus, a child can form a type of doll on the tiles adjacent a bathtub and vary the clothing associated with that doll. Surface tension and

the intervening water layer between the doll-shaped sheet and the clothes sheets allows that system of Kramer to function in its intended manner.

In sharp contrast to Kramer, Claims 1, 6 – 8, 10, 13 – 16, 20 and 21 relate to dolls and play sets including such dolls that are not characterized as planar, but are known in the ordinary three-dimensional sense and involve doll's garments which also have a three-dimensional shape. The garments are molded in particular shapes such that they will fit over the varied three-dimensional surfaces of portions of the doll in a life-like way. The garments and play sets of Claims 1, 6 – 8, 10, 13 – 16, 20 and 21 do not rely on the presence of water created surface tension to achieve the fit on the doll.

O'Brian discloses conventional doll structures and, as a consequence, one of ordinary skill in the art would have utterly no incentive or motivation to combine O'Brian with Kramer. Kramer is directed to "clothing" items that are essentially two dimensional, i.e. planar, and "dolls" that are not articulable. The clothing disclosed by O'Brian, such as that shown in Figs. 2 and 3, is shaped to "snap" its hard plastic pieces onto the non-articulable doll, as shown in Fig. 1. Such "snapping" action is a totally different mechanism to achieve positioning of the clothing relative to the doll or a doll-like shape as compared to Kramer, which relies on surface tension supplied by the presence of water.

Both of those technologies are different from each other and very different from the subject matter of Claims 1, 6 – 8, 10, 13 – 16, 20 and 21. The flexible and elastic injection molded thermoplastic elastomer doll's garments of Claims 1, 6 – 8, 10, 13 – 16, 20 and 21 are sized and shaped to fit over dolls in a life-like way, such that they are adaptable to articulable dolls. In other words, the doll's garments are donned in the same fashion that real people don or put on their clothes. For example, jackets are donned "arms first" and dresses, trousers and skirts

are “stepped into.” The fact that the dolls have articulated limbs and the garments are flexible and elastic and fitted in a life-like way over the doll, is neither taught nor suggested by either Kramer or O’Brian. Thus, dolls’ garments adapted for either or both of Kramer or O’Brian are not adaptable to articulable dolls as is the case of the garments of Claims 1, 6 – 8, 10, 13 – 16, 20 and 21. Thus, one of ordinary skill in the art, when attempting to design garments for articulable dolls or for dolls having articulated limbs, would have no incentive to use the teachings of either Kramer or O’Brian. As a consequence, one of ordinary skill in the art would have no incentive to make the hypothetical combination.

In particular, the Appellants respectfully submit that one skilled in the art would not make the hypothetical combination of a flat sheet of material from Kramer that is designed to adhere to another flat sheet of material by water induced surface tension with a hard yet resilient material of O’Brian that is intended to “snap on” a three dimensional doll. At best, the teachings of Kramer are such that the flat sheet of flexible polymer plastic would be adhered to the doll figure of O’Brian by water induced surface tension. In other words, one skilled in the art would take the flat sheet material of Kramer, place it or the doll of O’Brian into water and then wrap the flat sheet of material around the doll.

One skilled in the art would readily see the pitfalls of such an attempt. There would be almost no way to effectively do this in a doll that is life-like and has articulatable joints. Wrapping the Kramer sheet material would be virtually impossible in the first place and would surely be displaced upon any articulation of the various joints of the doll (which are neither taught nor suggested by either reference).

In any event, even if one skilled in the art were to make that hypothetical combination, the resulting structure would still be something completely different from that set forth in the

rejected claims. For example, Claim 15 recites a play set including a doll donned and fitted with a flexible and elastic injection molded garment which is molded to be removed, dressed and refitted again over external surfaces of the doll in a life-like way, the doll being articulated at a joint selected from the group consisting of joints of the shoulders, elbows, knees, neck and hips, the garment having a through hole accommodates passage of the doll's head or limbs and being molded from an elastomeric material. The combination of Kramer with O'Brian fails to teach or suggest this. It stretches one's imagination to consider that wrapping a flat sheet to be adhered to the surface of a doll through water induced surface tension as being "life-like" in any way. As a consequence, the Appellants respectfully submit that one skilled in the art would not make the hypothetical combination as set forth in the rejection.

One of ordinary skill in the art would have no incentive to make the hypothetical combination of O'Brian with Kramer as mentioned above and further in view of Gross. Gross fails to disclose, teach or suggest the cure for the deficiencies set forth above with respect to Kramer and O'Brian. There is no discussion of injection molding. Moreover, Gross uses a rigid core covered with an elastic skin that is not at all removable, but is partially adhered to the rigid core to facilitate selected areas where the skin may expand relative to the core to simulate changes in muscle tone or weight gain.

Gross is directed to a doll or toy figure that uses what is essentially a series of bladders that are able to expand and contract to portray weight gain or loss, muscle building, or the like. While Gross discloses a doll with articulated limbs, the bladder portions of Gross do not extend over the articulatable areas. Instead, the bladders are restricted to particular areas that do not include articulated portions. In sharp contrast, Claims 1, 6 – 8, 10, 13 – 16, 20 and 21 recite garments meant to be removed from an articulatable doll. As a consequence, even if one of

ordinary skill in the art were to make the hypothetical combination of both of Gross and Kramer with O'Brian, the resulting structure would still not result in, teach or suggest the injection molded thermoplastic elastomer doll's garment of Claims 1, 6 – 8, 10, 13 – 16, 20 and 21.

Hypothetically combining Wion would not cure the deficiencies of Kramer, O'Brian, and Gross as noted above. Thus, even if one skilled in the art combined them with Wion, the result would be structure that is far afield of the subject matter of Claims 1, 6 – 8, 10, 13 – 16, 20 and 21. Reversal of the rejection of Claims 1, 6 – 8, 10, 13 – 16, 20 and 21 is respectfully requested.

Washburn is directed to a method of stuffing the limbs of small dolls. The overall dimension can be 4 ½ inches in height. This disclosure is, however, directed to making dolls, not dressing them in a life-like manner. Thus, one skilled in the art would have no incentive to look to Washburn. The fact that 4 ½ inch tall dolls may have been known is utterly irrelevant unless there are teachings or suggestions in the art to make modifications that would lead to the claimed subject matter. There are no such teachings or suggestions in Washburn, O'Brian, Kramer, Gross or Wion.

Rejection of Claims 3 – 5 and 11 under 35 U.S.C. §103(a)

Claims 3 – 5 and 11 are rejected under 35 U.S.C. §103(a) over the hypothetical combination of O'Brian in view of Kramer and either Gross or Wion as applied to Claims 21 – 23, 25, 28 and 30 – 34 and further in view of Yasuda.

The Official Action of March 21, 2006 states that the “Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material.” The Appellants respectfully disagree. A modified device of Kramer fails to disclose, teach or suggest much more. Those deficiencies of O'Brian, Kramer, Gross and Wion have been clearly set forth

above with respect to the earlier rejection and need not be repeated here. However, they apply with the same effectiveness.

Even if one of ordinary skill in the art were to use the various materials disclosed by Yasuda as they apply to the specifics of Claims 3 – 5 and 11, the result would still be structures far different from those recited in Claims 3 – 5 and 11. For example, applying the materials of Yasuda to the “clothes” of Kramer would result in flat, planar garments designed to adhere to the flat, planar doll shaped cutouts disclosed by Kramer.

Similarly, if one of ordinary skill in the art were to use the materials of Yasuda for O'Brian, the result would be garments of the “snap-on” type having nothing to do with the garments and skins of Claims 3 – 5 and 11. In fact, one of ordinary skill in the art might very well hesitate to substitute the materials of Yasuda for the specific materials disclosed by O'Brian because substitution of such materials might destroy the “snap-on” ability of those garments as contemplated by O'Brian. Thus, hypothetically combining Yasuda with O'Brian and Kramer would still fail to teach or suggest flexible and elastic garments and skins adapted to be fitted, dressed and removed from a garment in a life-like way when the doll has articulated limbs.

Even if combined, O'Brian in view of Kramer and either Gross or Wion and Yasuda, would fail to teach or suggest the subject matter as recited in Claims 3 – 5 and 11. This rejection selects isolated bits and pieces of the claimed subject matter from at least four separate disclosures and combines them together with utterly no teachings or suggestions to do so. In order to hypothetically combine references, it is required that there be teachings or suggestions to 1) make modifications and 2) a reasonable chance of success that such modifications would be successful. Neither prong is satisfied here. As previously noted, there are no teachings or suggestions to combine Kramer with O'Brian inasmuch as O'Brian employs snap-on garments

whereas Kramer employs surface tension caused by the presence of water. Yasuda is non-enabling with respect to what kind of doll is contemplated. This is also sharply contrasted to Gross which employs dolls that have articulations, but uses bladders that do not cover the articulations. Thus, one of ordinary skill in the art would find neither teachings nor suggestions to either make the hypothetical combinations in the first place or give rise to a reasonable expectation of success upon making such combinations. Reversal of the rejection is respectfully requested.

Rejection of Claim 12 under 35 U.S.C. §103(a)

Claim 12 is rejected under 35 U.S.C. §103(a) over the hypothetical combination of O'Brian in view of Kramer and either Gross or Wion as applied to Claim 10 and further in view of Fogarty.

The Appellants have already established that one skilled in the art would not make the hypothetical combination of Kramer, Gross or Wion with O'Brian and, in any event, even if the hypothetical combination were to be made, that the resulting structure would still fail to teach or suggest the subject matter of Claim 12. The Appellants respectfully submit that further hypothetically combining Fogarty would still fail to cure the deficiencies set forth above. Fogarty provides no additional disclosure, teachings or suggestions that would cause one skilled in the art to make the hypothetical combination. Also, Fogarty fails to disclose, teach or suggest additional subject matter that would result in a garment that includes a doll donned and fitted with a flexible and elastic injection molded garment which is molded to the removed, dressed and refitted again over external surfaces of the doll in a life-like way. Reversal of the rejection of Claim 12 is respectfully requested.

Rejection of Claims 1 and 9 under 35 U.S.C. §103(a)

Claims 1 and 9 are rejected under 35 U.S.C. §103 over Yasuda in view of Kramer and further in view of O'Brian.

Yasuda fails to teach or suggest the subject matter of Claims 1 and 9 wherein the elastomeric material has a through hole to accommodate passage of a doll's head or limb(s). Instead, Yasuda discloses a multi-layered sheet. There is nothing in Yasuda concerning a through hole to accommodate passage of a doll's head or limb, and such a through hole is not inherent in the disclosure of Yasuda. There are multiple references on this record that already show various types of dolls clothes that do not contain such through holes. In that regard, the Appellants invite the Board's attention to U.S. 2,944,368 which discloses various dolls structures and associated clothes that do not have through holes. Therefore, the disclosure by Yasuda of a multi-layer sheet in no way makes a through hole inherent in such a sheet.

In addition, Yasuda fails to disclose, teach or suggest a seamless, injection-molded elastomeric material. Yasuda is quite clear that his laminate contains multiple layers. Laminates inherently contain multiple layers as previously noted. Those multiple layers inherently contain seams. Claims 1 and 9 recite that either the doll's garment or the doll's skin comprises a seamless, injection molded elastomeric material. Yasuda does not disclose, teach or suggest such a claimed structure. In sharp contrast, Yasuda discloses a structure that is a laminate formed of multiple layers which inherently contains seams. In fact, the Figures of Yasuda show the presence of seams. For example, Figs. 1 – 3 of Yasuda show, in each case, two seams in the Yasuda laminate, Figs. 6, 7, 8, 9, 15 and 16 – 18 all show two seams, Figs. 5 and 19 show one

seam, and the remaining figures show more than two seams. The fundamental essence of Yasuda is a laminate material that inherently contains seams, which are shown in each of the Yasuda Figures.

The Appellants agree that Yasuda states “clothes of dolls.” However, there is no disclosure, teaching or suggestion that the laminate itself is a “clothes of dolls” or should be wrapped to form clothes of dolls or would or could form a doll’s skin as recited in Claims 1 and 9. Instead, the entire sentence, which provides the proper context, states that the laminate can be cut into a shape and size so that the laminate portion can be used as a constituent element of clothes of dolls – not as clothes or skin by itself. By definition, the fact that the laminate is only a constituent element means that the laminate itself, taken alone, does not constitute a doll’s skin. At best, it can be a portion of or an attachment to a doll’s garment – not a doll’s skin.

As a consequence, neither Fig. 1 nor the paragraph spanning columns 19 and 20 of Yasuda disclose, teach or suggest a seamless doll’s skin. In fact, by virtue of the fact that Yasuda teaches that the laminate is only a constituent portion of a doll or doll’s skin, this inherently means that a doll’s garment utilizing the laminate as a constituent element would not be seamless and would not be wrapped around a doll and/or form a skin. There would need to be some means to attach the constituent element, i.e., the laminate, which inherently would produce some type of seam.

Accordingly, the Appellants respectfully submit that Yasuda does not teach a seamless doll’s skin, but that Yasuda teaches what would inherently be a portion of clothing for a doll’s garment having a seam by virtue of application of the laminate of Yasuda as a constituent element of such clothes. Yasuda does not intend for the laminate to be a doll’s skin, wrapped or otherwise, but only intends for the laminate to be a constituent part of the clothing so that it can

be utilized as a decorative element. This is briefly explained at the top of column 20 in line 2. It is simply for appearance, not functional use.

Claims 1 and 9 also call for a seamless doll's skin formed from an injection moldable thermoplastic elastomer in a molded shape to fit over at least a portion of a doll. The Appellants note with appreciation the Examiner's helpful comments concerning injection molding at column 5, line 42. That full paragraph states the following:

The resin molded articles which can be used as a resin layer of the laminate include small pieces other than films and extruded or injection molded articles of any shape and size.

The above paragraph refers to injection molded articles of any shape and size. However, it states that the resin molded articles are used as a resin layer of the laminate. In other words, Yasuda teaches injection molding articles as part of a single layer and then using those injection molded articles as constituents of a laminate. Yasuda does not teach or suggest that his invention (i.e. the laminate) is injection molded. It clearly is not as a result of the teachings of the paragraph in column 5 at the beginning of line 40. As a consequence, there are utterly no teachings or suggestions to those of ordinary skill in the art to injection mold a seamless doll's garment based on Yasuda. Yasuda's references to injection molding are merely formation of injection molded articles that can be used as part of a layer. This is not the same as a teaching or suggestion to injection mold a seamless doll's skin. Therefore, the doll's skin or doll's garment of Yasuda fails to teach or suggest a seamless, molded elastomeric material. Yasuda accordingly does not apply to any of Claims 6 – 11, 13 – 14 and 21.

Further, in Yasuda, there is no indication that at least a portion of the doll is partially bendable or articulated and/or that the doll's skin is sufficiently flexible and elastic to bend at bending or articulation locations of the doll. Yasuda briefly mentions a laminate that can have

fabrics bonded to the outermost resin layer to be effective for clothing for dolls. There is utterly no disclosure concerning a doll and/or the bendability or ability of the non-existent doll to be articulated. It inherently follows that there is no disclosure concerning the ability of the “clothing for dolls” to be sufficiently flexible and elastic to bend with non-existing bending or articulation locations of a doll.

Claims 1 and 9 recite a “doll’s skin” that covers and is removed from a portion of the doll and transforms the doll into a different character or object. Yasuda fails to disclose this. This can readily be seen by reference to the Appellants’ figures, such as Figs. 7A, 7B and 7C. In those three figures, a doll is covered with a doll’s skin and is transformed into a different character or object. It is readily seen that the figure of Fig. 7A is completely covered in Fig. 7C and is a different character. This is in sharp contrast to merely wrapping a laminate over a portion of a doll in an attempt to provide an element of clothing.

Finally, there is utterly no disclosure in Yasuda concerning the heights or sizes of the dolls and, accordingly, there is nothing on this record that supports the rejection of Claims 7, 8 and 10, which recite a height range of above 8 cm to about 20 cm.

Yasuda does not disclose that the garment has a wall thickness of 1 to 3 mm as recited in Claim 1 and 9. Additionally, Yasuda does not provide any guidance concerning the thickness of the laminate or the thickness of the resin layers forming the laminate. However, Yasuda does provide a multiplicity of examples which specifically set forth the thickness of the individual layers comprising the laminate. Those thicknesses are set forth in the chart for the Examiner’s convenience.

Example	Overall thickness (μm , or mm^{-3})
1	100
2	115
3	150
4	70
6	65
7	85
8	85
9	125
10	150
11	100
12	92
13	92
14	75
15	75
16	92
17	100
18	100
19	120
23	100
24	100

It is clear from these examples that the laminate thickness of Yasuda ranges between 65 μm all the way up to 150 μm . In sharp contrast, Claim 1 recites a wall thickness of 1 to 3 mm. The equivalent thickness is 1,000 μm to 3,000 μm . This is because the Yasuda laminate is for decorative purposes with no structural functionality.

There is a fundamental difference in thicknesses between Claims 1 and 9 and Yasuda and there are no teachings, disclosure or suggestions in Yasuda to increase the thickness at all, much less increase the thickness to the thickness recited in Claims 1 and 9. At a minimum, the claimed thickness is more than 6 ½ times larger than the thickness of the thickest Yasuda laminate. At the other end of the spectrum, the claimed range is over 46 times larger than that taught by Yasuda. One of ordinary skill in the art would not tend to increase the thickness of a laminate to make it easier to use on a doll assuming that the laminate was in fact a doll's skin. Logic suggests that removing the skin and reapplying it to a doll with legs and arms would only be

more difficult if the thickness were increased. Logic suggests that there would be no gain in the ease of playing with the doll and/or the doll's skin by increasing the thickness. It is well known that increasing thickness tends to make an item stiffer and less pliable relative to a thinner item.

As a consequence, the Appellants respectfully submit that Yasuda actually leads one of ordinary skill in the art away from the claimed wall thickness aspect of the invention. If one of ordinary skill in the art were to view the thickness teachings of Yasuda, one of ordinary skill in the art would tend to reduce the thickness to the level of Yasuda, not to increase the thickness to the claimed range, which is completely different from the taught thickness of the laminate of Yasuda. Thus, Yasuda teaches away from the claimed wall thickness.

Hypothetically combining Kramer with Yasuda would simply not be done by one skilled in the art. The concept behind the flexible sheet dolls of Kramer is utterly incompatible with the composite material of Yasuda. This is quite evident by even a cursory look at Yasuda wherein the portion at column 8 that briefly discloses clothing for dolls recites that the laminate can have fabric such as woven fabric, knitted fabric, braid, nonwoven fabric, lace and mesh bonded to the outermost resin layer thereof to have a soft texture and unique appearance. The Appellants respectfully submit that such structure is utterly incompatible with bathtub usage in the context of Kramer. Thus, one skilled in the art would surely not look to Kramer.

In any event, Kramer does not disclose a wall thickness of 1 – 3 mm. Instead, Kramer is replete with disclosure of flexible sheets of polymer plastic material between 2 mm and 6 mm. However, the fact that Kramer discloses flexible sheets of polymer plastic material between 2 mm and 6 mm in thickness is utterly irrelevant to the claimed injection molded elastomeric material having a thickness of 1 – 3 mm. Moreover, there is nothing in Kramer that teaches or suggests that the thickness was chosen merely as a “useful range” as a bath toy and that

preschool infants have a tendency to place objects in their mouths and must be able to withstand the biting and “other abuse” to which the pieces might be subjected. Thus, one skilled in the art would have no incentive to look to Kramer.

However, of greater importance is the disclosure in column 4 of Kramer beginning at line 5 that recites that stretching deforms the surface of the doll and adversely affects the ability of the doll to adhere by means of surface tension. What this means is that the Kramer “dolls” and the Kramer “clothes” are intended not to be stretchable, *i.e.*, elastic, and are intended instead to be flat and stiff to be able to maximize the ability of adherence by surface tension. This disclosure in Kramer makes it abundantly clear that one skilled in the art would not hypothetically combine Kramer with Yasuda.

The Appellants have already established that one skilled in the art would not hypothetically combine O’Brian with Kramer and there is nothing in O’Brian that would suggest that O’Brian and Kramer would or could be combined with Yasuda. As a consequence, O’Brian, Kramer and Yasuda are individually inapplicable to Claims 1 and 9 and are also inapplicable when taken in combination. Reversal of the rejection of Claims 1 and 9 is accordingly respectfully requested.

Provisional Double Patenting Rejection

The Appellants first protest addition of this rejection and the second reopening of prosecution after appeal, particularly after the issuance of six Official Actions during the initial prosecution. Such a rejection could and should have been issued long, long ago. This action is prejudicial to the Appellants by adding unneeded cost to pursue this appeal and the delay in the issuance of a patent. The Appellants respectfully request that the patent term of this application be extended in an amount commensurate in scope with the delay.

In any event, the Appellants respectfully request that further treatment of this rejection be held in abeyance pending resolution of the other aspects of their appeal.

Additional Arguments Applicable to all Claims

The Appellants were the first to invent the subject matter of Claims 1, 3 – 16, 18, 20 and 21 and have licensed that subject matter to a well known toy manufacturer and enjoyed great commercial success, which is indicium of nonobviousness. Since the subject matter was licensed, this invention has revolutionized fashion play in small dolls and the licensee will have sold over \$440,000,000 worth of product around the world and over \$220,000,000 in the U.S. in five years by the end 2003. A chart of sales through 2004 is as follows:

<u>Year</u>	<u>Worldwide</u>	<u>USA</u>
1999	8	7.5
2000	30	15
2001	78	38
2002	127	62
2003	200	100
2004	172	95
Total	615	317.5

The above figures do not include sales of boy's figures to licensees other than the one mentioned above. To obtain the retail value of the above sales, it would be necessary to double or triple those figures (which are licensee's sales value). In other words, sales of product with molded elastic clothes that are the subject of the solicited claims have exceeded \$1 billion in five years at retail value worldwide.

Also, the product, sold under the name “Fashion Polly” (under the Polly Pocket brand), was awarded the coveted Toy of the Year by Mattel (the world’s largest toy company). The product has single-handedly rescued a brand name (Polly Pocket) from the verge of extinction in 1999 and turned it around to be the best selling small doll in the world.

The undeniable commercial success of the product that is the subject of the license is because of the subject matter of Claims 1, 3 – 16, 18, 20 and 21 and not due to inordinate quantities of advertising. In fact, the amount of advertising spent on the product is below the “spend to sales ratio” of competitive toys. Also, unlike many of its peer products in boy’s and girl’s toys, it has not been the subject of any cartoon or other entertainment support along with the usual merchandising campaigns (e.g., like a Disney property, or Barbie). In spite of below average expenditure of funds in marketing the product, it has been a resounding success and has spawned many attempts by others to enjoy the financial rewards provided the Appellants’ advance in this art. There is no clearer proof of the non-obviousness of this product as set forth by the commercial success described above and the overt copying by others. A copy of a Declaration of one of the inventors that is already on the record is attached as Evidence Appendix.

The Appellants also note that a wide variety of hypothetical combinations of different prior art disclosures have been hypothetically combined to reject the solicited claims. However, those hypothetical combinations have either not been appropriate or, even if made, still fail to teach or suggest the invention of Claims 1, 3 – 16, 18, 20 and 21. Also, they rely on the notoriously tempting concept known as “hindsight.” This technology is not especially complicated and is, therefore, susceptible to its use. However, hindsight is strictly forbidden, irrespective of the relative complexity of Claims 1, 3 – 16, 18, 20 and 21.

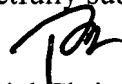
The Court of Appeals for the Federal Circuit has decisively confirmed this point in its recent decision *In re Fritch*, 23 U.S.P.Q. 2d, 1780 (Fed. Cir. 1992). The CAFC has clearly prohibited hindsight:

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." 23 U.S.P.Q. 2d at 1783 – 1784.

The foregoing discussion is binding with respect to this application. It is impermissible to pick and choose portions of a disclosure and use hindsight reconstruction to reject the Claims 1, 3 – 16, 18, 20 and 21.

The Appellants respectfully request that the rejection of Claims 1, 3 – 16, 18, 20 and 21 accordingly be reversed as to all claims.

Respectfully submitted,



T. Daniel Christenbury
Reg. No. 31,750
Attorney for Appellants

TDC/sh
(215) 656-3381

CLAIMS APPENDIX

1. A seamless doll's skin comprising a seamless, injection molded elastomeric material sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which repeatedly covers and is removed from the doll and transforms the doll into a different character or object, has a wall thickness from 1 to 3mm, has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll.

3. The skin of claim 1 wherein the elastomeric material is a synthetic polymer.

4. The skin of claim 3 which is a copolymer.

5. The skin of claim 4 wherein the copolymer is selected from the group consisting of one of the following: ethylene vinyl acetate copolymer, styrene-butadiene-styrene, styrene-isoprene-styrene, styrene-diene, styrene-isoprene-butylene block copolymers containing mineral oil, branched styrene copolymer, styrene butadiene, styrene-butadiene triblock, styrene-isoprene-styrene linear block polymer, styrene-butadiene radial block copolymer, butadiene-styrene copolymer.

6. A doll's skin comprising a seamless, injection molded elastomeric material which covers and is removed from at least a portion of a doll that is at least partially bendable or articulated and transforms the doll into a different character or object, wherein the elastomeric

material has a 100% modulus of elasticity between about 120 and 350KN/m², has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll.

7. The skin of claim 1 wherein the garment is adapted in size to be fitted to and removed from the doll having a height of less than about 8cm.

8. The skin of claim 2 wherein the garment is adapted in size to be fitted to and removed from the doll having a height of above 8cm to about 20 cm.

9. The skin of claim 1 in a form selected from the group consisting of animal, human, monster, super hero, robot, and cartoon character.

10. A seamless doll's garment comprising a seamless, injection molded elastomeric material having a molded shape to repeatedly fit over and removed from a doll having a height in the range of above 8cm to about 20cm, has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at articulation locations of the doll.

11. The doll's garment of claim 10 wherein the elastomeric material is a synthetic polymer.

12. The doll's garment of claim 11 further comprising at least one integrally molded detail.

13. A doll's skin comprising a seamless, injection molded elastomeric material which covers and is removed from at least a portion a doll that is at least partially bendable or articulated to transform the doll into a different character or object, and wherein the elastomeric material has a 100% modulus of elasticity between 120 and 350 KN/m², has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll.

14. The doll's skin of claim 13 wherein the elastomer material has a 100% modulus of elasticity between 240 and 280KN/m².

15. A play set comprising, in cooperative combination, a doll that is at least partially bendable or articulated and having a height in the range of 8 cm to about 20 cm, donned and fitted with a seamless synthetic polymer injection molded garment which removably encloses around at least a part of the doll and is adapted to be removed, dressed and refitted again to the doll wherein the synthetic polymer has a 100% modulus of elasticity between about 120 and 350KN/m², has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll.

16. The play set of claim 15 wherein the doll is articulated at one or more of the following: shoulders, elbows, knees, wrists, ankles, neck, head and hips.

18. The play set of claim 15 wherein the synthetic polymer has a 100% modulus of elasticity between about 240 and 280KN/m².

20. A seamless doll's garment comprising a seamless, injection molded elastomeric material sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which is repeatedly fitted over and removed from the doll, has a wall thickness from 1 to 3 mm, has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll.

21. A seamless doll's garment comprising a seamless, injection molded elastomeric material sized and shaped to approximate the size and shape of at least a portion of a doll that is at least partially bendable or articulated which is repeatedly fitted over and removed from the doll, wherein the elastomeric material has a 100% modulus of elasticity between 120 and 350 KN/m², has a through hole to accommodate passage of a doll's head or limb(s) and is sufficiently flexible and elastic to bend at bending or articulation locations of the doll.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.